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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/612,945	07/10/2000	Tomoo Tsunenari	37B.P61	9915

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EXAMINER

POND, ROBERT M

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 05/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/612,945

Applicant(s)

TSUNENARI, TOMOO

Examiner

Robert M. Pond

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 05 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 July 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The Applicant amended the specification to overcome Drawing objections cited in the previous Office Action. The Applicant amended Claims 1, 10, 15, 16, and 23. All pending claims (1-27) were examined in this final Office Action.

Response to Arguments

35 USC 101 Rejection

Applicant's arguments, see Remarks regarding Office Action rejection under 35 USC 101 page 13, filed 05 March 2004, with respect to Claims 1 and 7-9 have been fully considered and are persuasive. The rejection of Claims 1 and 7-9 has been withdrawn.

35 USC 103(a) Rejection

Applicant's arguments filed 05 March 2004 have been fully considered but they are not persuasive.

The Applicant argues USPS and SmartShip do not teach a) automatically determined destination, determined based on the received identity of the consumer product and the received present location, and b) automatically determined carrier service. USPS and SmartShip teach online merchandise return, recyclable toner cartridges as returnable product, customers printing shipping labels on laser printers and affixing labels for return package shipping,

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and returning destination based on the product type. USPS and SmartShip teach automatically routing a package based on product characteristics (additional prior art not previously cited included for Applicant's review as noted under Conclusion). USPS and SmartShip further teach automatically determining a carrier based on consumer's location. Though not relied upon, it is well within the skill to ascertain that a returned product, which is processed by a specific returns center location and not by another return center location, should be routed to the location that can process the returned product. Included for the Applicant's review is patent number 5,242,944 (Kelly et al.) that implements this concept at the facility level.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 1. Claims 1, 5-6, 10, 13, 15-16, 22-23, and 26 are rejected under 35 USC 103(a) as being unpatentable over USPS (a collection of articles cited in Paper #12, PTO-892, Items: U-X) in view of SmartShip (a collection of articles cited in Paper #12, PTO-892, Items: UU-VV).**

USPS teaches Returns@ease software program (please note the software program contains code for the computer to execute) allowing customers to notify a participating web merchant about the item they wish to return, printing out on the customer's printer in seconds a pre-paid merchandise return label from the company's retail web site, and returning the item via pickup or drop-off at a mailbox of post office (Item: U, please see page 1). USPS teaches recyclable toner cartridges as returnable items, the practice of high-end retailers including shipping labels with products and using United Parcel Service's authorized return service and e-shipping that allows online customers to pay by credit card, generate a label, and drop the package off at a UPS counter (Item: U, see page 2). USPS teaches a) Altrec.com implementing USPS' electronic merchandise return service, also known as Returns@ease, which allows the company to credit

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customers faster than traditional cataloguers or brick-and-mortar companies that include return labels with every shipment, b) when Altrec.com's electronic return label is created the company's warehouse and customer service people are immediately alerted and have all the information about the item being returned, reason, and price (Item: U, see page 2), and c) Altrec.com testing the online program with USPS in the middle of September 1999, scanning returned merchandise label and automatically crediting the customer's credit card (Item: V, see page 1). USPS teaches Return@ease receiving return shipping data from a merchant's web site, customers printing out the label, which is actually a two-dimensional indicia or bar code containing shipping information, on any printer (Item: W, page 1), and expanding the returns service to reroute the package to an online auctioneer, who would sell the item and then send the proceeds to the retailer (Item: X, page 1).

USPS teaches all the above as noted under the 103(a) rejection and teaches a) USPS' electronic merchandise return service (Returns@ease) automatically determining the carrier service and transmitting a merchant's address (destination for the returned product) information to be printed by the customer to be affix to the returned merchandise's packaging, and b) routing a returned merchandise package to a third-party destination (e.g. auctioneer) based on type of product (e.g. product is not selling well) (Item: X, page 3), but does not disclose automatically determining a present location of the merchandise. SmartShip teaches SmartShip.com receiving approval to provide electronic

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retailers access to the USPS electronic merchandise returns services (Item: UU, see page 1), and further teaches use of customer zip code and shipping destination zip code to compare shipping rates and to select among a finite list of competing carriers displayed to the user (Item: UU, page 1, Item: VV, page 1).

Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify USPS to include zip code information to determine present location of the merchandise as taught by SmartShip, in order to determine a cost effective carrier service.

- 2. Claims 2-3, 17-18, and 24-25 are rejected under 35 USC 103(a) as being unpatentable over USPS (a collection of articles cited in Paper #12, PTO-892, Items: U-X) and SmartShip (a collection of articles cited in Paper #12, PTO-892, Items: UU-VV), as applied to Claims 1, 16, and 23, further in view of Caldwell (Paper #12, PTO-892, Item: UUU).**

USPS and SmartShip teach all the above as noted under the 103(a) rejection and teach merchandise return processing via a web site, and transmitting purchase information during the approval process but do not disclose product serial numbers and customer information stored in a database. Caldwell teaches reverse logistics as the handling and disposition of returned goods, being crucial for online sales due to staggering amount of returned products, and WorldSpy integrating online reverse logistics into its shopping portals. Caldwell teach customers filling out a return notice on WorldSpy's web site, customers being

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advised to send the item(s) to a central warehouse managed by UPS Worldwide Logistics or directly back to the manufacturer, and teach building the system using Visual Basic and Microsoft's SQL Server 7.0 database. Caldwell further teaches Great Plains Software concentrating on reverse logistics, and implementing a returns management module that uses serial numbers to track returned parts throughout the process (Item: UUU, see at least pages 2-3, and 6). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system, method, and program code of USPS and SmartShip to include use of product serial numbers in a reverse logistics process and web sever database to manage information as taught by Caldwell, in order to efficiently track and manage the online returns process.

- 3. Claims 4, 11-12, and 27 are rejected under 35 USC 103(a) as being unpatentable over USPS (a collection of articles cited in Paper #12, PTO-892, Items: U-X), SmartShip (a collection of articles cited in Paper #12, PTO-892, Items: UU-VV), and Caldwell (Paper #12, PTO-892, Item: UUU), as applied to Claims 2, 10, and 23, further in view of Lidsky (Paper #12, PTO-892, Item: VVV) and Williams et al. (Paper #12, patent application publication number 2002/0032573).**

USPS, SmartShip, and Caldwell teach all the above as noted under the 103(a) rejection but do not disclose using name and password identification. Lidsky teaches SmartShip.com competing with iShip.com in the same market to

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provide customers with an easy way to pick a carrier service. Williams et al. teach the system and method of iShip.com of providing online merchandise return services, storing information in databases, and further teach use of name and password protection by authorized customers and customer printing shipping label for selected package carrier (see at least abstract; Fig. 7; Fig. 30a (22, 4362); Figs. 30b-c; Fig. 31 (4402); Fig. 32 (4420); Fig. 34 (22, 752, 815); Fig. 36 (900, 907, 908); Fig. 52 (330); col. 14, paragraph 0262 through col. 16, paragraph 0281). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system, method, and program code of USPS, SmartShip, and Caldwell to include customer identification information as taught by Lidsky and Williams et al., in order to attract users wanting to use a secure commerce site for shipping return

- 4. Claims 7, 9, and 19-20 are rejected under 35 USC 103(a) as being unpatentable over USPS (a collection of articles cited in Paper #12, PTO-892, Items: U-X) and SmartShip (a collection of articles cited in Paper #12, PTO-892, Items: UU-VV), as applied to Claims 1 and 16, further in view of PR Newswire (Paper #12, PTO-892, Item: WW).**

USPS and SmartShip teach all the above as noted under the 103(a) rejection and teach a recyclable toner cartridge as a returnable product and the customer printing the return shipping label on any type of printer and specifically on a laser printer (Items: U, page 2; W, page 1; UU, page 1), but do not specifically disclose

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a laser printer toner cartridge as a returnable recyclable product. PR Newswire teaches Canon USA introducing new laser printers into the market place, the use of laser toner cartridges, Canon USA instituting the Clean Earth Campaign in 1990 which supports environmental issues, and collecting millions of toner cartridges for recycling and reuse. Therefore it would have been obvious to one of ordinary skill in the art to modify the system and method of USPS and SmartShip to disclose laser printer toner cartridges as returnable product for recycling as taught by PR Newswire, in order to attract customers desiring to return recyclable laser toner cartridges.

5. **Claims 8 and 21 are rejected under 35 USC 103(a) as being unpatentable over USPS (a collection of articles cited in Paper #12, PTO-892, Items: U-X), SmartShip (a collection of articles cited in Paper #12, PTO-892, Items: UU-VV), and PR Newswire (Paper #12, PTO-892, Item: WW), as applied to Claims 1 and 20, further in view of Martin (Paper #12, PTO-892, Item: XX)**

USPS, Smartship, and PR Newswire teach all the above as noted under the 103(a) rejection and teach Canon recycling printer cartridges, but do not disclose the use of a chip adapted to a printer cartridge to collect product information. Martin teaches laser printer toner cartridge recycling, Canon competitors producing Canon compatible cartridges, and introduction of smart supplies used in laser printers, and by example the Lexmark LaserJet 8100 cartridge having chips that provide feedback to users on toner usage and other information.

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Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of USPS, SmartShip, and PR Newswire to include a chip adapted to a product as taught by Martin, in order to facilitate efficient product use.

- 6. Claim 14 is rejected under 35 USC 103(a) as being unpatentable over USPS (a collection of articles cited in Paper #12, PTO-892, Items: U-X) and SmartShip (a collection of articles cited in Paper #12, PTO-892, Items: UU-VV), as applied to Claim 10, in view of Gralla (Paper #4, PTO-892, page 2, Item: V).**

USPS and SmartShip teach all the above as noted under the 103(a) rejection further teach transmitting information via a web interface, but do not disclose the use of a cookie to pass or collect information from the customer's computer. Gralla teaches the use of cookies by Internet web sites to pass and collect information from a web client computer. Gralla teaches cookies as bits of data being deposited on a client's hard disk when visiting the web site, and the cookie being used to convey information to the server. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of USPS and SmartShip to use the customer's cookie as taught by Gralla, in order to make it easier to conduct electronic business with the web server.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- US 5,424,944 (Kelly et al.) 13 June 1995; teaches product return processing.
- SmartShip.com; Internet Archive Wayback Machine, www.archive.org; www.smartship.com, 04 March 2000; teaches SmartShip.com automatically determining a carrier based on consumer location and characteristics of the package.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Mr. Vincent Millin** can be reached on 703-308-1065.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

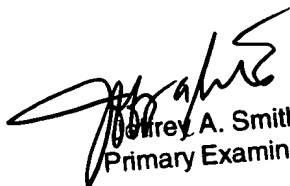
Washington D.C. 20231

or faxed to:

703-872-9306 (Official communications; including After Final communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

Robert M. Pond
Patent Examiner
May 17, 2004


Jeffrey A. Smith
Primary Examiner